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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,085	12/02/1999	KATSUTOSHI SAKAO	SONYJP3.3-0	9445

530 7590 05/22/2003

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EXAMINER

ARMSTRONG, ANGELA A

ART UNIT

PAPER NUMBER

2654

DATE MAILED: 05/22/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/445,085

Applicant(s)

SAKAO ET AL.

Examiner

Angela A. Armstrong

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2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 50-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 05, 2003 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 53 and 57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 53 and 57 include limitations drawn such that the first output terminal is preferentially selected. Upon reviewing the specification, the Examiner could not find support for the limitation.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 50-52, 54-56, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (US Patent No. 6,199,076) in view of Case (US Patent No. 6,516,299).

4. Regarding claim 50, Logan teaches a receiver for receiving compressed digital data as converting received digital signals to analog for use with a speaker (col. 4, lines 55-59) and storing the received data on a replaceable media (col. 7, lines 63-66)

Additionally, Logan teaches a decoder for decoding the received compressed digital data to provide decoded digital data as a stereo codec at col. 4, lines 55-56

Additionally, Logan teaches compressed data of a plurality of contents at col. 5, lines 55-col. 6, lines 5 in which Logan teaches that the compressed data consists of audio programs, announcements, text, image, advertising segments and program catalog information and col. 44, lines 5-48 in which Logan teaches of Audio Programming with HTML which allows for interactively browsing audio programs with synchronized images, conversion of HTML to synthetic speech, and viewing and printing of narrative text.

Logan teaches a first output terminal for providing the compressed digital data to an external device through a bi-directional data communication line at col. 4, line 46-50.

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Logan teaches a second output terminal for providing the decoded digital data to the external device through a one-way data communication line at col. 7, lines 63-66.

Logan does not specifically teach a controller that determines which type of data to provide to an external device as a function of a connection state with the external device. However, selectively providing data type to a device as a function of the device capabilities was well known in the art.

In a similar field of endeavor, Case teaches a method and system for modifying audio signals for compatibility of a selected playback destination. Specifically, Case teaches implementation of a controller which identifies one of a plurality of destinations, modifies the audio data as needed to be compatible with the identified destination, and transmits the audio data to the destination (col. 4, line 46 continuing to col. 5, line 29).

Therefore, it would have been obvious to one of ordinary skill at the time of the invention to modify the system of Logan to implement a controller for controlling the type of data output to external devices, as provided by Case, for the purpose of ensuring that the transmitted data can be fully utilized at the receiver.

Regarding claim 51, Logan teaches converting the received digital signals to analog for use with a speaker (col. 4, lines 55-59).

Regarding claim 52, receiving compressed digital data and additional information at col. 5, lines 55-col. 6, lines 5, wherein the additional information includes images (col. 6, lines 1-3; col. 5, lines 55-59), character information (col. 4, lines 46-50, col. 5, line 55 – col. 6, line 5), compressed tunes (col. 5, lines 55-63) and the audio data and additional information are distributed through digital broadcast (col. 40, lines 18-21).

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Regarding claims 54-56 and 58, claims 54-56 and 58 are similar in scope and content to claims 50-52, and are rejected under similar rationale.

5. Claims 53 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (US Patent No. 6,199,076) in view of Case (US Patent No. 6,516,299), as applied to claims 50 and 54 above, in further view of well known prior art.

6. Regarding claims 53 and 57, Logan and Case teach everything as claimed in claims 50 and 54. The combination does not specifically teach that the controller carries out control so that a connection for providing the received compressed digital data to an external device is preferentially selected. However, preferentially providing compressed data to an external device was well known in the art as a mechanism for reducing data storage requirements.

Therefore, it would have been obvious to one of ordinary skill at the time of the invention to preferentially provide compressed data to an external device in the audio distribution system of Logan, for the purpose of reducing data storage requirements, as was well known in the art.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Katz et al (US Patent No. 5,926,624) teaches a digital information library delivery system with logic for generating files targeted to the playback device.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela A. Armstrong whose telephone number is 703-308-6258. The examiner can normally be reached on Monday-Thursday 7:30-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

Angela A. Armstrong  
Examiner  
Art Unit 2654

AAA  
May 19, 2003

*Marsha D Banks-Harold*  
MARSHA D. BANKS-HAROLD  
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